

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

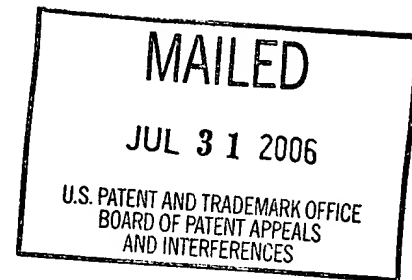
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DENNIS GROSS

Appeal No. 2006-2306
Application No. 09/338,729

ON BRIEF



Before ADAMS, MILLS, and LEOVITZ, Administrative Patent Judges.

LEOVITZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to methods of treating skin. The examiner has rejected the claims as obvious over prior art. We have jurisdiction under 35 U.S.C. § 134. We reverse.

Background

Skin renewal treatments are widely used for improving the condition of aging skin and treating dermatological conditions, such as acne. Specification, page 1. Generally, skin renewal treatments involve the application of chemicals to the skin which remove ("peel") its outer keratinous layer, exposing underlying layers that are smoother and appear younger. Id. In typical chemical treatments, the skin is contacted with an acid

(e.g., alpha-hydroxy acids) for a time duration which is effective for the outer layer of skin to be “peeled” off. Id., pages 1-2. Chemical peels, however, are invasive and irritating to the skin, requiring high concentrations of acid or other harsh peeling agents, and long time periods in which the agent is in direct contact with the skin. Id., page 2. As a consequence, they typically cause “pain and inflammation to the skin.” Id.

The claimed subject matter is directed to a skin treatment technology that is described as being gentler to the skin than prior art methods which use high acid concentrations. Id., page 3. The methods are directed to “a two-step acid peel” in which a first acid composition is applied to the skin, and then a second alkaline composition is applied over the acid in an amount to neutralize it. Id.

Discussion

Claims

Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 76-78, 85, 88, and 90-117 are on appeal. Claim 90 is the broadest claim. It reads as follows:

90. A method for treating skin, comprising the sequential steps of:
- a) applying to the skin a first dermatological liquid composition comprising an effective amount of a skin renewal stimulating acid and a cosmetically acceptable vehicle, wherein the pH of the first dermatological liquid composition is between about 2.5 and about 4;
 - b) neutralizing the first dermatological liquid composition by applying to the skin a second dermatological liquid composition comprising an alkaline agent suitable for use in a skin care composition, about 0.1% to about 10% by weight of at least one surfactant/emulsifying agent and a cosmetically acceptable vehicle, wherein the pH of the second dermatological liquid composition ranges from greater than about 7 to about 12;

- c) allowing the second dermatological liquid compositions to dry on the skin; and
- d) applying to the skin a moisturizer, sun screen and/or makeup when the first and second dermatological liquid compositions remain on the skin.

Claim 90 has four main steps. First, a first composition containing a “skin renewal stimulating acid” having a pH that is “between about 2.5 and about 4” is applied to the skin. Second, the acid is neutralized by a second composition that contains an “alkaline agent” and “about 0.1% to about 10% by weight of at least one surfactant/emulsifying agent.” The pH of the second composition is “greater than about 7 to about 12.” The second composition is allowed to dry on the skin in the third step. Finally, in a fourth step, “a moisturizer, sun screen and/or makeup” is applied “when the first and second dermatological liquid compositions remain on the skin.”

There are three additional independent claims on appeal, claims 40, 44, and 117. Independent claims 40 and 44 are constructed like claim 90, but have further limitations, inter alia, that the first and second dermatological liquids comprise a list of recited components. Claim 117 is similar to claim 90, but rather than stating that the first and second dermatological liquids remain on the face ((step d) in claim 90), it requires that the liquids are not rinsed off before applying “moisturizer, sun screen and/or makeup.”

Obviousness under 35 U.S.C. § 103

Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 77, 78, 85, 88, 90-99, 101-106, and 109-117 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davis¹ in view of Rapaport².

Davis describes a foamable cosmetic mask product for application to the skin. Davis, column 1, lines 4-18; column 2, 65-column 3, line 10. The product comprises two compositions which are separately applied to the face. Id. The first composition is characterized as a “cream” and contains an effervescent agent, such as bicarbonate or carbonate salts. Id., column 3, lines 10-40; column 7, lines 39-44. The second composition contains an acid component. Id., column 3, lines 40-60. Any cosmetically effective acid can be used, including alpha-hydroxy acids. Id., column 8, line 65-column 9, line 14. The second composition is also referred to as a “gel” or “gel activator.” Id., column 3, lines 60-65; column 4, lines 5-8. Both compositions are thickened to prevent them from appreciably flowing after application to the face. Id., column 3, lines 11-13, 35-38, 41-43, and 61-65. When the compositions are applied sequentially to the face, the reaction of the effervescent agent (first composition) with the acid (second composition) liberates a gas that produces a “foaming action.” Id., column 1, lines 40-47; column 2, 42-52. The resulting “residue is removed from the skin of the user by means of a scraper or cloth.” Id., column 1, lines 47-49. In a preferred embodiment,

¹ Davis, U.S. Pat. No. 5,720,949, issued Feb. 24, 1998

² Rapaport, U.S. Pat. No. 5,505,948, issued Apr. 9, 1996

the skin can be pretreated with moisturizers, prior to application of the cosmetic mask.

Id., column 2, lines 53-62.

Rapaport provides a skin peeling/exfoliation system that contains low concentrations of peeling agents that allow them “to be left on the skin of the user for a relatively extensive duration.” Rapaport, column 8, lines 35-37. According to Rapaport, their “invention ... does not need to remove or neutralize the active skin peeling agent because the reduced concentrations thereof can be left upon the skin.” Id., column 9, lines 52-55. The peeling agents include acetone and acids, such as alpha-hydroxy acids. Id., column 8, lines 59-62; column 14, Table 1-column 15, Table 2.1. After application of the peeling agent, Rapaport states that a moisturizer or sunscreen can be applied. Id., column 13, lines 15-20; 54-58; column 14, line 4.

The examiner argued that the combination of Davis and Rapaport renders the claimed subject matter unpatentable. The reasoning was summarized as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the skin treatment method of Davis by substituting the Rapaport acid peel/exfoliation composition for the acidic composition, as motivated by Rapaport, because 1) Davis teaches that it may be desirable to maintain an acidic composition on the skin for a gentle peel; 2) and the skilled artisan would have had a reasonable expectation of successfully achieving a gentle acid-peeling effects while the composition remains on the skin, as taught by Rapaport.

Answer, page 8.

Appellant traversed the examiner's rejection, arguing that there was a lack of motivation to have modified Davis by replacing the acid composition with Rapaport's composition.

This is because Rapaport specifically states that the skin-peeling composition of Rapaport “is intended to be left upon the skin of the user without the neutralization or removal required in the prior art” (column 8, lines 46-48; emphasis added). However, the effervescent composition of Davis would neutralize any acid previously applied because the effervescent composition contains an effervescent agent such as the sodium, potassium or ammonium salt of bicarbonate or carbonate, which is a base that reacts with the acid (column 7, lines 32-35; column 10, line 66 to column 11, lines 19-20).

Brief, paragraph spanning pages 7-8.

The examiner bears the initial burden of showing unpatentability. See, e.g., In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness requires evidence that the prior art disclosed or suggested all of the elements of the claimed invention, and that those skilled in the art would have been motivated to combine those elements with a reasonable expectation of success. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1443 (Fed. Cir. 1991).

We agree with Appellant that the examiner has not established motivation to have modified Davis by the addition of a step of applying “moisturizer, sun screen and/or makeup,” when the cosmetic mask remains on (claims 40, 44, and 99) or has not been rinsed from (claim 117) the face. Brief, page 10, (A)(I)(iii).

According to the examiner, the motivation to have substituted Rapaport’s acid composition in Davis’s facial mask was for the reason that “Davis teaches that it may be desirable to maintain an acidic composition on the skin for a gentle peel.” Answer, page 8. The problem with this reasoning is that it does not provide a rationale for allowing the

acidic composition to remain on the skin while additional treatments to it are applied as required in step d) of claim 90.

The examiner believed that “washing off or the removal” of Davis’s facial mask is “an optional step.” Answer, page 12. However, Davis expressly states that the “residue” which remains after the effervescent agent reacts with the acid “is removed from the skin of the user by means of a scraper or cloth.” Davis, column 1, lines 47-49; column 12, lines 2-4. Thus, we do not see how Davis’s removal step can be characterized as optional.

The examiner further argued:

While Davis is directed to a [sic] using cream mask and gel composition, the reference also teaches that lotion or cream formulation that are massaged into the skin had been widely used in the art. See Davis See col. 1, lines 27 - 32. The reference also teaches that these compositions are not removed. Thus whether the composition is in the form of viscous cream mask or liquid, these conventional forms are merely viewed as different means of carriers for the active ingredients to the skin so that the reaction of the effervescent agent and acid component can take place thereon.

Answer, page 12.

In other words, the examiner concludes that when Rapaport’s acid composition is substituted for Davis’s acid component, it would have been rubbed into the skin, and remain there, because that’s the way lotions are ordinarily used.

However, we do not find support for the examiner’s characterization of Davis. In the “Background” section, Davis clearly defines two different kinds of skin treatment products: 1) those which are massaged into the skin, and 2) those (“face masks”) which are applied to the skin and then removed.

The prior art products of the lotion or cream type are generally massaged into the skin of the consumer. Accordingly they are not removed. Face masks are also available, generally referred to as “mud packs,” that once applied to the surface of the skin harden to form a crustlike film, removable by soap and water.

Davis, column 1, lines 27-32.

Thus, lotion/creams which are designed to be massaged into the skin, and not removed, are not interchangeable with the components of a facial mask, which is intended to be removed from the skin. Davis describes its own invention as a “cosmetic mask product” that is “removed from the skin,” consistent with the definition of a facial mask in the patent’s “Background” section. Id., column 1, lines 35-37, 47-49. The examiner’s suggested modification to Davis – putting a massagable cream into a facial mask, and then leaving the entire concoction on the skin – would eliminate the normal function of a facial mask that requires its removal from the face when the treatment is complete. In our view, the proposed modification would render the prior art facial mask “inoperable for its intended purpose,” and therefore there is no suggestion or motivation to make it. In re Gordon, 733 F.2d 900, 901, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In particular, the examiner’s suggestion to apply moisturizer on top of the facial mask, without stripping it from the face, would make Davis’s cosmetic mask product inoperable as a facial mask³.

The examiner also argued that “Rapaport does not in any way teach against [using a] neutralization step in the skin peeling process. The reference merely teaches that the neutralization is optional ... See Rapaport, col. 11, lines 23-29.” Answer, page

³ This is especially the case since Davis describes its product as a “relatively viscous cream-gel mixture” that apparently requires friction to remove it. Davis, column 11, lines 21-22.

13. This argument is misplaced. Rapaport describes its own acid composition as being left in contact with the facial skin without removing or neutralizing it. Rapaport contrasts this composition with the prior art, which requires application of the acid composition “followed by the relatively quick neutralization or removal of peeling agents.” Rapaport, column 11, lines 23-25. Thus, Rapaport distinguishes its skin treatment from the prior art on the basis that it does not require that the acid component be neutralized or otherwise removed from the skin.

In sum, the evidence of record fails to support a prima facie case of obviousness. This rejection is reversed.

Claims 76, 100, 107, and 108

Claims 76, 100, 107, and 108 stand rejection as being obvious over Davis in view Rapaport as applied to claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 77, 78, 85, 88, 90-99, 101-106, and 109-117, and further in view of Linn⁴, Hahn⁵, and McAtee⁶.

Claims 76, 100, 107, and 108 are dependent claims that require the dermatological liquids to have specific components. The additionally cited references are relied upon by the examiner for teaching these claimed components. Answer, pages 9-10. We do not find that these additional references to overcome the deficiencies as described above, nor to provide the requisite motivation to have combined Davis and Rapaport. Thus, this rejection is also reversed.

⁴ Linn et al. (Linn), U.S. Pat. No. 4,797,273, issued Jan. 10, 1989

⁵ Hahn et al. (Hahn), U.S. Pat. No. 5,804,203, issued Sept. 8, 1998

⁶ McAtee et al. (McAtee), U.S. Pat. No. 5,811,111, issued Sept. 22, 1998

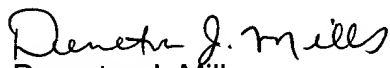
Summary

The rejections of claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 76-78, 85, 88, 90-117 over prior art are reversed.


REVERSED



Donald E. Adams
Administrative Patent Judge



Demetra J. Mills
Administrative Patent Judge



Richard M. Lebovitz
Administrative Patent Judge

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